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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,721	06/15/2001	Takeshi Kikuchi	393032025900	9175
25224	7590	12/06/2004	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			NGUYEN, PHUOC H	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/882,721

Applicant(s)

KIKUCHI ET AL.

Examiner

Phuoc H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-118 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-118 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9,17-19,21-27,37,39-45,65-67,70-74, and 115-117, drawn to content distribution system which fulfilling the client request and response through the use of electronic mail, classified in class 709, subclass 206.
  - II. Claims 10-11,20,28-29,35-36,46-48,50-61,75-76,94-102,104,106,108,110, and 112 drawn to a content distribution system which distribute content item request from the client device to the portable terminal based upon the data representing an environment of content execution, classified in class 709, subclass 231.
  - III. Claims 12-16,30-34,49,62-64,68-69,77-93,103,105,107,109,111,113,114, and 118 drawn to a database searching with a specify condition, and displaying result based upon the content-specifying data, classified in class 709, subclass 217.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions of Group III is related as combination and subcombinations of Group I-II. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombinations as claimed for patentability, and (2) that the subcombinations has utility by itself or in other combinations (MPEP 806.05c). In the instance case, the combination (Group III) as claimed does not require the particulars of the subcombinations (Group I-II) as claimed because to both subcombinations and combination are presented and assumed to be patentable, the omission of specific detail of the subcombinations as

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recited in claims 1-11,17-29,35-48,50-61,65-76,94-102,104,106,108,110,112, and 115-117, in the combination as recited in claims 12-16,30-34,49,62-64,68-69,77-

93,103,105,107,109,111,113,114, and 118 is evidence that the patentability of the combination does not rely on the details of the specific subcombinations. The subcombinations of Group I-II has separate utility such as content distribution system which fulfilling the client request and response through the use of electronic mail, and a content distribution system which distribute content item request from the client device to the portable terminal based upon the data representing an environment of content execution.

4. Inventions of the Group I-II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group I-II have separate utility such as content distribution system which fulfilling the client request and response through the use of electronic mail, and a content distribution system which distribute content item request from the client device to the portable terminal based upon the data representing an environment of content execution. See MPEP 806.05(d).

5. Because these inventions are distinct for the reasons given above and the search required a separate status in the art as shown by their different classification, the search required for one Group is not required for other Groups, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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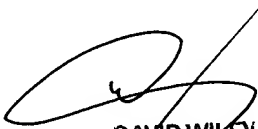
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Mon -Thu (7AM-4: 30PM) and off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H. Nguyen  
Examiner  
Art Unit 2143

December 2, 2004

  
DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100